

REMARKS

Reconsideration of this application is requested.

The claims have been amended to emphasize novel features of the invention. More specifically, claim 13 has been amended to specify the substance of claim 24. As a consequence, claims 18, 19, 21, 22 and 24 have been canceled to avoid redundancy. The dependency of claims 23 and 25 has been appropriately amended, taking into account deleted claims. Additionally, claims 20 and 26 have been amended in a way which is thought to improve the form of these claims. No issues of new matter are raised by the amendments.

With entry of this amendment, the pending claims are claims 13, 14, 15, 20, 23 and 25-28. All of these claims are thought to be allowable for the reasons noted herein.

With reference to the issues raised by the Examiner's action, the specification has been appropriately amended so as to obviate the Examiner's objection as set out in ¶ 1 of the action.

The objection to claim 13 is no longer applicable in view of the amendments made to the claim.

Reconsideration of the provisional double-patenting rejection is requested in view of the attached Terminal Disclaimer with respect to Appln. No. 11/417,162.

Reconsideration and withdrawal of the Section 102(b) rejection of claims 13-14, 18-22 and 26-27 based on Miyatake et al. (U.S. 2002/0043464) is requested. As noted earlier, claim 13 has been amended to include the features of claim 24 which is not included in the Examiner's Section 102(b) rejection. The applicants do not agree with the Examiner's Section 102(b) rejection. However, the indicated amendment of claim 13 to include the features of claim 24 should obviate this rejection.

The Examiner is respectfully requested to reconsider the Section 103(a) rejection of claims 23-25 and 28 (now, in essence, claims 13, 23, 25 and 28) as unpatentable over the published Miyatake et al. application. The Examiner has acknowledged that Miyatake et al. do not disclose the specific amounts of TiO₂, mica and metallic Al called for by the applicants' claims. However, the Examiner has taken the position that it would have been obvious from Miyatake et al. to determine the optimum combination of pigment, hiding material and pearlizing compound.

With respect, the applicants submit that the Examiner is not warranted in considering the amounts of mica, TiO_2 and particulate Al called for in the applicants' claims to be nothing more than an obvious choice. The invention defined by applicants' main claim 13 calls for specific components in specific amounts to obtain a specific result. There is no motivation in Miyatake et al. to select the applicants' specific components and use them in the specified amounts and relationship to obtain the applicants' results.

More specifically, Miyatake et al. are concerned with addressing the prior art disadvantages by improving corrosion and weather resistance, costs and productivity in the automobile body coating processes and preventing reduction in opacifying properties, unfavorable sagging and coating thickness, by using a W-Coat electro deposition process. There is nothing in the Miyatake et al. objectives or otherwise to motivate one to select the specific constituents and amounts thereof which are called for in applicants' claim 13 for any purpose, much less to give the improved pearlescent effect of the finished product of the present invention.

It is only by hindsight in the light of the applicants' disclosure that one could come up with the applicants' specific combination of specific materials in specific amounts to obtain the results sought by the applicants. Hindsight cannot be used to justify a Section 103(a) rejection. Clearly the applicants' process as defined in amended claim 13 is new and the composition used therein is not disclosed or suggested by Miyatake et al. for any purpose, to say nothing of the applicants' specific purpose of obtaining a pearlescent white finish on a substrate. Accordingly, withdrawal of the Section 103(a) rejection of applicants' claims based on Miyatake et al. is requested.


For essentially similar reasons, the Examiner is requested to reconsider and withdraw the Section 103(a) rejection of claims 13-15 and 18-28 (now claims 13-15, 20, 23, 25 and 26-28 with main claim 13 representing, in essence, claim 24) as unpatentable over Fowler et al. (U.S. 4,978,708). Fowler et al. do not show or suggest the specific composition used in the applicants' process, i.e. the combination of mica, TiO_2 and particulate metallic Al in the amounts specified in claim 13, for the applicants' purposes. The specific combination of features required by the applicants' claim 13 is not obvious and there is no motivation in Fowler et al. to make the specific selections required to reach the applicants' invention. A myriad of experiments is needed to discover the pearlescent advance provided by the

invention defined by applicants' claim 13. Clearly, there is no motivation or teaching in Fowler of the applicants' small range of specific compounds and amounts in admixture to obtain the special results sought by the applicants. Accordingly, it is submitted, with respect, that the applicants' process, as defined by the presently amended claims, is novel, not obvious and, therefore, should be patentable.

All issues having been addressed, the applicants respectfully submit that the application is in condition for allowance. Accordingly, allowance is requested.

Respectfully submitted,

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